

PATENT

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on
November 19, 1996.


Jennifer Taylor

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of: CHATTERJEE et al.

Art Unit: 1813

Serial No.: 08/372,676

Examiner: J. Reeves

Filing Date: January 17, 1995

For: ANTI-IDIOTYPE MONOCLONAL
ANTIBODY 1A7 AND USE FOR THE
TREATMENT OF MELANOMA AND
SMALL CELL CARCINOMA

COMMUNICATION IN RESPONSE TO
ENTRY-IN-PART OF AMENDMENT UNDER 37 CFR § 1.312(a)

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

The present communication is filed following notification in Paper 28 (mailed October 25, 1996) that the 37 CFR § 1.312 amendment filed on September 25, 1996 has been entered in part.

No substantive action is requested of the Examiner. This Communication is submitted to indicate that applicants do not acquiesce to certain comments made by the Examiner in

PATENT
Serial No. 08/372,676
Docket No. 304142800300
Docket No. 434-047

Paper 28. Applicants request that this Communication become part of the file history of the subject application.

Applicants acknowledge entry of claims 40-46 and 48. Applicants are grateful to the Examiner for her consideration of this matter and discussions with applicants' attorneys.

The Examiner declined to enter claim 47 into the application on the grounds that the claim raises new issues under 35 USC § 112 ¶ 1, which would require more than a cursory review of the record. Applicants recognize that once the issue was raised, evaluation under 37 CFR § 1.312 was not pursued — in other words, the Examiner did not come to a conclusion as to whether a deficiency under 35 USC § 112 ¶ 1 exists.

To the extent that the issue has been raised, applicant responds with the following two comments.

First, newly entered claims 44 and 45 recite methods for eliciting active immunity, including production of anti-GD2 antibody, comprising administering monoclonal antibody 1A7 to an individual. Proposed claim 47 depends from claim 44, and also recites a method for eliciting active immunity. In claim 47, the individual in which the active immunity is elicited is suspected of having a particular cancer. No evidence has been presented to show that the presence of the cancer in the individual would be an impediment to the eliciting of the active immunity.

Second, the Examiner states that one skilled in the art would not know how to raise paratopic antibodies. Applicants respectfully remind the Examiner that Claim 47 is satisfied simply if anti-GD2 antibody is produced. Whether or not antibodies are elicited in the individual against other components of the 1A7 molecule is not addressed in the claim. Abundant evidence of the ability of 1A7 to elicit production of specific anti-GD2 antibody in mice, rabbits, and cynomolgous monkeys is provided throughout the application.

Claim 47 is therefore fully supported in the subject application, which meets the requirements of 35 USC § 112 ¶ 1. Applicants reaffirm their intention to pursue the subject

PATENT
Serial No. 08/372,676
Docket No. 304142800300
Docket No. 434-047

matter of claim 47 in a divisional or continuation-in-part application, citing priority to the present application as filed.

Respectfully submitted,



J. Michael Schiff
Registration No. 40,253

MORRISON & FOERSTER
755 Page Mill Road
Palo Alto, CA 94304-1018
(415) 813-5600
Fax: (415) 494-0792

November 19, 1996